



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

#13
10/12/02
TRR

In re Application of

Miller et al.

Serial No. 09/263,812

Filed: March 8, 1999

For: Restaurant Videoconferencing System and Method

Group Art Unit 2643

Examiner: Eng, G.

APPEAL BRIEF

Honorable Assistant Commissioner of
Patents
Washington, D. C. 20231

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Sir:

Further to the filing of Appellants' Notice of Appeal in this application, Appellants' hereby submit the Appeal Brief in triplicate. The Appeal Brief fee of \$165.00 is enclosed herewith in the form of a check. Please charge any shortages in fees to deposit account no. 50-1088, and credit any excesses to the same deposit account.

I. REAL PARTY IN INTEREST

There are no parties in interest in the above-captioned patent application other than the two inventors, Miller and Phipps.

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II. RELATED APPEALS AND INTERFERENCES

No other appeals or interferences exist which relate to the above-captioned patent application.

III. STATUS OF CLAIMS

Claims 1-20 are presently pending in this application. All claims stand finally rejected under 35 USC § 103(a).

IV. STATUS OF AMENDMENTS

No amendments have been made to the claims subsequent to the issuance of the final rejection, and the claims on appeal are those as submitted with Appellants' response of January 11, 2002.

V. THE INVENTION

The invention relates to the novel and unobvious combination of a number of features, none of which are taught or suggested by the prior art. That is, the prior art does not teach the videoconferencing restaurants as claimed, and having a number of booths to accommodate a number of people for eating and other services such as videoconferencing, internet access, computer games, etc., particularly over different geographic time zones. This time zone feature significantly increases the number of

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guests/table turns (seatings) in each restaurant, leading to increased customer accounts and much improved sales and profits.

Page 5 of the specification details the numerous advantages associated with the invention. Figures 1-4 of the drawings and their description in the specification, see the bottom of page 9, detail the various features of the booths as they would be found in each restaurant.

Figure 5 details the network aspect of the system with Figure 6 showing the system with two locations in different times zones and the capability for multimedia access in each booth.

VI. ISSUES

One issue for this appeal is whether claims 1, 2, 4, 7, 8, 16, and 17 are unpatentable under 35 USC § 103(a) in light of the combined teachings of United States Patent Nos. 4,074,793 to Yuter (Yuter I), 4,800,438 to Yuter (Yuter II), and 5,374,952 to Flohr.

Another issue is whether claims 3, 5, 6, 18, and 19 are unpatentable in view of the combined teachings of Yuter I, Yuter II, and Flohr when these teachings are combined with United States Patent No. 5,929,849 to Kikinis.

A third issue is whether claims 9-15 and 20 are unpatentable under 35 USC § 103(a) based on the combined teachings of Yuter I and Flohr.

VII. GROUPING OF CLAIMS

The claims do not stand or fall together. Each of claims 1, 2, 7-11, 13, 14, and

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17-20 are separately patentable over the applied prior art.

VIII. THE ARGUMENTS

The invention's concept and purpose offers public access in a restaurant environment to high end integrated media/technology, for business/pleasure connecting people across great distances (virtual travel) via videoconferencing and to all types of media, broadband, internet, interactive PC, broadcast and cable TV.

The rejection relies on a combination of Yuter I and II, which is a restaurant telephone-based socializing tool, ultimately enhanced to add menu ordering on a small TV screen, all within a restaurant, and Flohr, which offers specific applications for networked, primarily one on one PC conferencing. Yet neither impacts the venue (public) with participants (large table) or multi-purpose (business/pleasure) aspects as set forth in the claims. The invention is effectively one method and system that could be used for one aspect, yet having several options for other uses.

Claim 1

In the rejection of claim 1, the Examiner admits that Yuter I does not teach the claim limitations regarding the viewing screen, the plurality of seating areas, videoconferencing, and the sizing of the table. At most, Yuter I discloses a restaurant that uses a telephone for voice only communication between tables within the restaurant, see col. 3, lines 20-49.

In response to this deficiency, the Examiner cites Yuter II for the teaching of the use of a more compact telephone with a TV monitor that can display food specials, and display other types of signals in place of the telephone of Yuter I, see col. 3, lines 13-21.

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The Examiner concludes that it would be obvious to use the telephone of Yuter II in place of the one of Yuter I. Despite combining the two references, the Examiner still admits that the combination does not teach videoconferencing in a public area at tables in two different geographic locations. The Examiner then cites Flohr to show that videoconferencing in a network is known. The Examiner concludes that, given the teachings of Flohr, it would be obvious to modify the telephone system of Yuter I/II and employ videoconferencing.

The rejection of claim 1 is flawed since the Examiner has not established a *prima facie* case of obviousness based on the cited art.

With respect to a rejection under 35 U.S.C. § 103(a), it is well settled that the Examiner bears the initial burden of presenting a *prima facie* case of obviousness. In *re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993); In *re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1943, 1945 (Fed. Cir. 1992). "A prima facie of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art." In *re Bell*, 991 F.2d 781, 782, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993). Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. In *re Kotzab* 208 F.3d 1352, 54 USPQ 2d 1308 (Fed. Cir. 2000).

A rejection based on 35 U.S.C. § 103(a) must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. In making this evaluation, the Examiner has the initial duty of supplying the factual basis for the rejection. The Examiner may not, because of doubt that the invention is

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patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis. See *In re Warner*, 379 F.2d 1011, 154 USPQ 173 (CCPA 1973), cert. denied, 389 U.S. 1057 (1968). The Federal Circuit has also repeatedly cautioned against employing hindsight by using applicant's own disclosure as a blueprint to reconstruct the claimed invention from the isolated teachings of the prior art. See, e.g., *Grain Processing Corp. v. American Maize-Products Co.*, 840 F.2d 902, 907, 5 USPQ 2d 1788, 1792 (Fed. Cir. 1988).

First, the rejection of claim 1 is improper since Yuter I and II do not teach the limitations of claim 1 regardless of Flohr. Second, there is no motivation to combine Flohr with either Yuter I or II without resorting to the hindsight reconstruction of the prior art in light of Appellants' own disclosure.

Claim 1 requires that the plurality of seating areas are arranged so that the viewing screen can be viewed from the seating areas. The Examiner addresses this claim limitation by taking the position that the rotating telephone of Yuter II teaches this claim limitation. One is effectively an enhanced happy hour socializing, the invention being a pre-planned virtual travel experience.

This position is unsubstantiated in light of Yuter II. A close analysis of Yuter II reveals that the telephone 10 must be rotated to each individual for viewing, see col. 5, lines 1-11. This means that it is the screen that is adapted or moved with respect to individual seats in Yuter II. This is the opposite concept of claim 1, wherein it is the seats that are arranged or adapted so that the screen can be seen from each of the seats, so that videoconferencing can take place. In other words, Yuter II does not teach that the screen can or should be viewed by all sitting at the table. Thus, even with

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Flohr, Yuter I and II fail to suggest this claim limitation.

Moreover, one would not be taught to modify the screen of Yuter II since this would directly conflict with the reason for telephone's rotation, i.e., allow selective viewing of the screen by individuals at the table.

Appellants also take issue with the Examiner's interpretation of claim 1 to read on two different areas in a single restaurant as meeting the language of first and second restaurant geographic locations. Appellant contends that this is an improper interpretation of claim 1. As noted above, one aspect of the invention is directed to the concept of offering a planned meeting by bringing people together in a dining atmosphere via videoconferencing as opposed to meeting "new" people within the same restaurant.

Claim 1 calls for a first restaurant geographic location and a second restaurant geographic location. In the final rejection, see page 3, lines 1-3, the Examiner contends that the bar and dining areas 12 and 18 of Yuter I are different geographic locations, but offers no reasoning as to why this is so. Then, on page 3, lines 17-19, the Examiner admits that neither Yuter I nor Yuter II teach videoconferencing between tables in two different geographic locations.

Notwithstanding the incongruity in this aspect of the rejection, a fair reading of Yuter I and II, and one admitted by the Examiner, indicates that Yuter I and II do not teach first and second restaurant geographic locations. Both Yuter I and II are directed to a single restaurant, and the assertion that the different areas of Yuter I are the claimed first and second restaurant geographic location makes no sense in the context of the claim.

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Claim 1 is directed to a system that requires videoconferencing between the booths in different geographic locations. With the Examiner's interpretation of claim 1, the invention would be directed to videoconferencing between booths in the same restaurant. This makes absolutely no sense; why would people in one restaurant booth videoconference with people in a booth adjacent to the one booth? Therefore, regardless of whether Flohr is properly combined with Yuter I and Yuter II, the two Yuter references do not teach this element of claim 1.

Lacking the two features of the claimed noted above, i.e., the booth arrangement and two different restaurants, the rejection fails for these reasons alone.

Further, the rejection fails since the proper motivation to combine is lacking in the rejection. In the final rejection, the basis for the combination is stated as follows:

Therefore, it would have been obvious to modify the combination of Yuter I and Yuter II in having a capability of providing videoconferencing between terminals in different geographic locations, as per teaching of Flohr, because it upgrades the restaurant dining system so that it enable terminals to participate flexibly in multimedia exchanges with media terminals on a network in order to conduct videoconferences even though the selected terminals are local on different networks."

This passage does not supply the motivation to put videoconferencing in the restaurants of Yuter. The language that the Examiner relies upon can be found in the Summary of the Invention section of Flohr, and it is clear that this particular object is referring to the nuances of videoconferencing in a network. The Examiner improperly refers to the advantages of the system of Flohr as the motivation requirement necessary for a rejection under 35 USC § 103(a). The problem with this approach is that Flohr has nothing to do with a restaurant or an ordering system in a restaurant that uses a telephone. Flohr's import is a particular system that enhances videoconferencing

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between networked computers, and is devoid of any teaching or suggestion relating to a restaurant or how to improve restaurant operation, particularly restaurant profitability.

Appellants are not claiming to be the first to use videoconferencing on a network, nor claiming to have invented a superior videoconferencing system on its own. Moreover, there is a likelihood that the videoconferencing system may include none of Flohr's enhancements when being implemented. The instant application is based on the use of videoconferencing and multimedia in a unique way and not the particulars of videoconferencing as is improved by Flohr.

What Appellants are claiming to be the first to do, is to use videoconferencing in two different restaurants and restaurant locations in a booth arrangement not heretofore taught or suggested by the prior art. As noted above, the invention vastly increases the profitability of the restaurant by generating media revenue, and more table turns (customers) for the restaurant.

In the Examiner's response to Appellants' arguments, the Examiner again concludes that it would be obvious to modify Yuter I and II in order to upgrade the restaurant dining system by enabling terminals to participate flexibly in multimedia exchanges with media terminals on a common network or different networks. Again, the Examiner has drawn a conclusion of obviousness by merely identifying the advantages of Flohr, but still fails to say why one of skill in the art would modify differently-located restaurants with videoconferencing capability.

The lack of motivation is underscored by the incongruity between Yuter I and II and Flohr. Yuter I and II are concerned with allowing patrons in a restaurant to use a table-located telephone to place an order for their meal or talk to another patron. As

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part of this capability, Yuter II also provides a TV, but people at the table cannot all see the screen.

Yuter I and II do not teach interaction between parties at dining tables in different locales by use of the telephone; the telephone is for ordering or communication between patrons in the restaurant. Yuter I and II are effectively socializing enhancers; their use has no relationship to organized long distance communication or access to high end business and entertainment interactive media.

Admitting that Yuter I and II do not teach the type of communication claimed, the Examiner turns to a patent that discloses a particular videoconferencing system, i.e., Flohr, and concludes that it would be obvious to provide intercommunication between the restaurants' tables because videoconferencing in a local area network or different networks is known.

The mere fact that videoconferencing is known does not obviate the invention. The Examiner must supply the proper objective basis in fact to support a rejection under 35 USC § 103(a). Merely citing an objective of Flohr as the all important "why" that is required when making a rejection based on a combination of references does not establish the proper motivation to modify Yuter I and II. The ability of terminals to participate flexibly in multimedia exchanges, as taught by Flohr, has nothing to do with a restaurant operation, and provides no impetus to modify Yuter I and II as alleged in the final rejection. The only basis to modify Yuter I and II is the impermissible use of the hindsight reconstruction of the prior art in light of Appellants' disclosure, and this cannot serve as a basis for the rejection under 35 USC § 103(a).

In fact, since ordering using the phones is vital to the Yuter I/II operation,

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providing communication between restaurants in different locations makes absolutely no sense in the context of these references. The menu on the screen of Yuter II does not obviate every use of the screen no more than the existence of videoconferencing obviates all uses of this technology. One of skill in the art would not be motivated to link the telephones of different restaurants for ordering or meeting people. Put another way, Yuter I and II teach away from the instant invention and cannot serve as a basis to obviate the invention. This teaching away further substantiates Appellants' contention that the prior art does not obviate the invention.

The fact that Yuter II combines a TV with a telephone does not suggest videoconferencing/internet/PC (TV's do not obviate PC's) applications or suggest interaction with other restaurants. Further, the small TV of Yuter II does not meet the limitation that the viewing screen be seen from the plurality of seats as is required by claim 1.

Claim 2

The basis to reject claim 2 is improper. The Examiner concludes that because Flohr teaches that videoconferencing can be in a different network that the terminals for conferencing would be found in different time zones. This observation misses the point and does not address the issue at hand. Claim 2 raises the issue of whether it would be obvious to put the booths of Yuter I in a different time zone, and not whether the terminals of Flohr may be in different time zones or not. The mere fact that Flohr may have videoconferencing in different time zones does not answer the question of obviousness. The real question is whether there is a reason to put the booths of Yuter I

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in a different time zone and connect them, and the answer to the question is plain. There is no reason or motivation to do so. In fact, since Yuter I relates to a single restaurant and employs the telephones for ordering purposes, there would be no need or use to have such capability between two restaurants, and such a modification lacks the objective basis in fact needed to support the rejection.

Therefore, the Examiner has not established a *prima facie* case of obviousness against claim 2.

Claims 7 and 8

As with claim 2, the Examiner merely cites a feature of Flohr and then concludes that claims 7 and 8 are obvious. Claims 7 and 8 define the system by specifying, in addition to the claimed booths, the existence of a videoconferencing room and computer stations with videoconferencing, respectively. The Examiner cites Figure 8 and its description in Flohr as a basis for rejecting these claims. While this description describes the two work groups as being in different floors, it is unclear as to how this disclosure motivates one to modify the combination of Yuter I and II. These claims define an additional videoconferencing capability other than that provided by the booths, and this dual capacity is not found in the applied prior art. Actually, the rejection fails to identify where the concept detailed in claims 7 and 8 is found in the prior art, and therefore lacks a basis to conclude that these claims are unpatentable under 35 USC § 103(a).

Claim 9

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The rejection of claim 9 based on Yuter I and Flohr fails for the same reason that the rejection of claim 1 fails.

The Examiner has not established a *prima facie* case of obviousness because the prior art lacks the requisite motivation to modify Yuter I as alleged in the final rejection.

As noted above, given Yuter I's purpose of telephone ordering and interaction between parties in a restaurant, providing a link between tables in two differently-located restaurants makes no sense.

Claim 9 defines a method, which requires a number of restaurants. Yuter I describes a single restaurant. The Examiner has not provided any basis to modify Yuter I to include a number of restaurants. Thus, regardless of whether Flohr is combined with Yuter I, the rejection is deficient for failing to suggest the plurality of restaurants as claimed.

The rejection of claim 9 is also flawed since there is no motivation to modify Yuter I as alleged in the final rejection, and a *prima facie* case of obviousness is lacking.

The very same reasons set forth above for the traversal of the rejection of claim 1 regarding Flohr applies for claim 9. The Examiner again merely draws a conclusion of obviousness because videoconferencing on a network is taught by Flohr. While Flohr proposes networked-videoconferenced facilities, how they are networked is not relevant to the invention. The rejection concludes obviousness without a reason to do so, other than using hindsight after reading Appellants' disclosure.

Claims 10, 11, and 20

The Examiner makes the same error in rejecting claims 10, 11, 20 as rejecting claim 2. The issue is not what Flohr teaches but whether one would modify Yuter I and arrive at the invention of claim 20. Again, just because Flohr teaches using different networks does not mean that one of skill in the art would be driven to make Yuter I into two restaurants and divide them by the expanse of an ocean, different time zones, or international borders. The rejection fails since the Examiner again has not provided the requisite reasoning as to why one of skill in the art would modify Yuter I.

Claims 13 and 14

These claims are rejected on the same basis as claims 7 and 8, and the rejection is flawed for the same reasons argued in support of the patentability of claims 7 and 8. That is, the mere fact that Flohr teaches having work groups in different floors of a building does not lead to the conclusion that one would provide additional computer stations and rooms with videoconferencing in the restaurant of Yuter I. Flohr would only guide the "how" to videoconference, not the act or use of videoconferencing as proposed in the instant claims. Again, the Examiner has not supplied the "why" the artisan would make the proffered modification; again merely drawing a conclusion without support. Therefore, claims 13 and 14 are separately patentable over the combination of Yuter I and Flohr.

Claim 17

The rejection of claim 17 also fails for the reasons set forth regarding claim 1. That is, the combination of Yuter I and II do not teach the claimed booth arrangement for the reasons set forth above. The rotatable TV screen of Yuter II does not meet the limitations of claim 17. It is clearly designed for a single viewer since the screen must rotate so that others at the table can see it and it is not designed with cameras so another person could be seen on the screen. Claim 17 requires that the seating be arranged so that the patrons at the booth can see the viewing screen for videoconferencing, and this capability is not even remotely suggested by Yuter II. The seats and screen are not arranged in Yuter II for viewing by those in the seats. Therefore, a *prima facie* case of obviousness has not been established for claim 17.

Claims 18 and 19

The rejection of claims 18 and 19 is based on the assumption that one of skill in the art would find it obvious to modify the Yuter I and II/Flohr combination and include Internet access and computer games. The basis for this rejection is the reliance on Kikinis and its teachings of using separate windows in a TV to access different media, see col. 2, lines 1-5.

The problem with these rejections is again a lack of motivation to modify the prior art to arrive at the claimed invention. These claims define the multi-media aspect of the invention wherein the restaurant is able to offer other

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options to its patrons if videoconferencing is delayed, cancelled, interrupted for some reason, or just not desired. By having a multi-media booth in the restaurant, patrons have options that enhance their experience in the restaurant, and the restaurant itself is not limited to just videoconferencing as an attraction. There is also the public access component of the invention that offers anyone access on an as needed basis to the integrated media that is lacking in the prior art.

Kikinis is directed to a combined TV-internet access system that allows viewers to gain maximum information about entities of interest as seen in TV transmissions, see col. 2, lines 52-59.

Yuter I and II are concerned with restaurant operations, and provide peripherally a small TV screen for the table.

Flohr is different yet in teaching a way to videoconference between networked computers. While Flohr suggests that a cable or television signals may be inputted into the system, see col. 9, lines 25-37, it does not suggest the multi-media approach espoused by claims 18 and 19.

Appellants contend that the Examiner is cobbling together the references by means of hindsight, and not basing the combination of references on motivation derived from the prior art. None of the cited references teach or suggest the multi-media concept defined in claims 18 and 19, and the rejection fails for this reason. The purpose of Flohr and Yuter I/II bear little or no resemblance to any of the purposes of the invention as set forth by the claims.

Alternatively, even if the references are combined, they do not teach all

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of the limitations found in claims 18 and 19. In fact, the rejection cites Flohr, col. 5, line 41 to col. 6, line 66 to allege that satellite TV, cable TV, productivity tools, resources, and programs are disclosed. However, Flohr at most teaches inputting television signals and the use of the computer as a telephone, but nowhere does Flohr suggest the use of productivity tools, or the inventory of computer games or programs. Even with the combined references, each and every limitation of the invention as set forth in claims 18 and 19 is not taught or suggested, and the rejection as applied to these claims is improper.

CONCLUSION

In summary, Appellants assert that the Examiner has not established a *prima facie* case of obviousness against claims 1, 2, 7-11, 13, 14, and 17-20. Thus, these claims along with dependent claims 3-6, 12, 15, and 16 are patentable over the cited prior art.

The applied prior art reference does not teach or suggest the inventive concept and such an absence underscores the complete lack of motivation to modify Yuter I and II, or Yuter I alone, which taints the Examiner's rejection under 35 U.S.C. § 103(a). The Examiner has also improperly used hindsight and, as such, has improperly concluded as a matter of law that the claimed invention is obvious.

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Appellants' respectfully request that the Board of Appeals reverse the Examiner's decision in this application, and direct the Examiner to pass this application onto issuance.

Respectfully submitted,

A handwritten signature in cursive script, reading "Christopher W. Brody". The signature is written in dark ink and is positioned above the printed name and registration number.

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APPENDIX

1. A restaurant videoconferencing system comprising:
 - a) a first plurality of booths in at least a first restaurant geographic location;
 - b) a second plurality of booths in at least a second restaurant geographic location;
 - c) at least one booth in each of the first and second locations being equipped with at least one viewing screen and connected via a network providing both videoconferencing between booths in different geographic locations and multi-media access for each booth, wherein each at least one booth has a table and a plurality of seating areas, the plurality of seating areas arranged so that viewing screen is visible from the plurality of seating areas, and the table sized to accommodate serving a meal to a plurality of individuals in the seating areas.
2. The system of claim 1, wherein the booths of the first location are in a different time zone from the booths in the second location.
3. The system of claim 1, wherein each booth has high speed internet access.
4. The system of claim 1, wherein each booth has access to one or both of cable TV and satellite TV.
5. The system of claim 1, wherein each booth has access to a central server of computer games.
6. The system of claim 1, wherein the booth has access to at least one of internet access, cable TV, satellite broadcast, productivity tools, resources, and an inventory of computer games and programs.
7. The system of claim 1, wherein each location also includes at least one room, each room having videoconferencing capability with a room or booth in a different location.

8. The system of claim 7, wherein each location has computers stations with videoconferencing capability in addition to the rooms and booths.

9. A method of restaurant videoconferencing comprising the steps of:

a) providing a plurality of videoconferencing booths in each of a number of restaurants, each restaurant in a particular geographic location; and

b) conducting videoconferencing between users in at least two booths in different restaurant locations while offering food and/or beverages to the users in each booth.

10. The method of claim 9, wherein the restaurants are in different time zones.

11. The method of claim 9, wherein the restaurants are in different countries.

12. The method of claim 9, comprising providing one of internet surfing, computer gaming, computer program access, cable TV viewing, broadcast TV viewing, satellite TV during step (a).

13. The method of claim 9, comprising providing videoconferencing capability in rooms and computer stations in addition to the booths for users of the restaurant.

14. The method of claim 13, comprising providing videoconferencing capability in rooms and computer stations situated in each location in addition to the booths for users of the restaurant

15. The method of claim 9, wherein a plurality of individuals are present at each booth and interact at each booth for one of social and business pleasure in a public setting.

16. The system of claim 1, wherein multiple parties interact at each booth for one of social and business pleasure in a public setting.

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17. The method of claim 9, wherein each booth has a table and a plurality of seating areas, the plurality of seating areas arranged so that viewing screen is visible from the plurality of seating areas, and the table sized to accommodate serving a meal to a plurality of individuals in the seating areas.

18. The system of claim 1, wherein each booth has internet access, cable TV, satellite broadcast, productivity tools, resources, and an inventory of computer games and programs.

19. The method of claim 9, wherein each booth has internet access, cable TV, satellite broadcast, productivity tools, resources, and an inventory of computer games and programs.

20. The method of claim 11, wherein the countries are separated by an ocean.